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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,918	12/31/2003	Brian C. Reising	8R08.1-020	1405
23506	7590	03/08/2006		
GARDNER GROFF SANTOS & GREENWALD, P.C. 2018 POWERS FERRY ROAD SUITE 800 ATLANTA, GA 30339			EXAMINER WERNER, JONATHAN S	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,918

Applicant(s)

REISING, BRIAN C.

Examiner

Jonathan Werner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/6/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 & 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 & 30-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-23 and 30-35 in the reply filed on 2/6/06 is acknowledged. An action on the merits of claims 1-23 and 30-35 follows below:

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(e), which papers have been placed in the file. Application for patent was filed not later than 12 months after the date on which the provisional application was filed. Additionally, patent application contains or is amended to contain a specific reference to the provisional application.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 5/12/04 was filed before the mailing date of a first Office Action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 26' and 26" in Figure 2 are both referenced to in the specification as 26a

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and 26b respectively. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: the bracket opening and body are both referenced as 16, while the attachment and body are both referenced as 14 (paragraph 0074, line 2). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites the limitation "the openings." There

is insufficient antecedent basis for this limitation in the claim. As to claim 16, applicant claims that the "opening is tubular with open ...". For the purpose of examination, it will be understood that the only limitation set forth in this claim is that the opening is tubular.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 17, 20-21, 30 and 34-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to recite part of the human body in combination with the structure of the claimed invention, i.e. an orthodontic appliance "attached to a plurality of teeth." It has been held that a claim directed to or including within its scope, a human being will not be considered to be patentable subject matter under 35 USC 101. The grant of limited, but exclusive property right in a human being is prohibited by the Constitution. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). Applicant needs to clearly state using inferential language that the human anatomy is not claimed. For examination purposes, the claims will be considered as if such limitations involving the combination with a human were not present.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 and 14-15, 17, 19-20, 30 and 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Takemoto (US 6,264,468). As to claim 1, Takemoto discloses an orthodontic bracket (28) for use with a wire to reposition a tooth comprising a body (31) defining a coextensive opening (29,30), wherein the body does not have a base with a surface area for bonding directly to the tooth (Figure 15), and wherein the position of the opening is fixed and the bracket is positionable at an angle relative to the tooth surface without any part of the body creating a lever arm with the tooth surface (Figure 1). As to claim 2, Figure 1 shows the body comprises a gingival sidewall (top surface of 33), an occlusal sidewall (bottom surface of leg 32), and a lingual sidewall (right surface of body 31) that define an opening (29,30) that is open on a tooth side. As to claim 3, Figure 22B shows the body has a low profile width that is equal to a depth of the opening plus a thickness of the lingual sidewall. As to claim 4, Figure 1 shows the bracket is positionable offset from the tooth or adjacent to the tooth, wherein no part of the bracket contacts the tooth when the bracket is offset from the tooth (Figure 1), and the sidewalls contact the tooth when the bracket is adjacent to the tooth (column 5, lines 65-67 & column 6, lines 1-5). As to claim 5, Figure 1 shows the opening (29) is rectangular and remains level when the bracket is positioned adjacent to or offset from a vertical or non-vertical surface of the tooth. As to claim 6, Figures 1 and 22B show the gingival sidewall has a length that is greater than a length of the occlusal sidewall. As to claim 7, the body comprises one or more retention wings (32 and wing

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portion to the right of slot 36) extending therefrom. As to claim 8, Figure 22B shows the body has a low profile width that is equal to a depth of the opening plus a thickness of the lingual sidewall plus a horizontal extension of the wings. As to claims 9 and 10, Figures 1 and 14A show the opening is rectangular and the wings are angled relative to the opening and that the wings are curved away from the tooth as they extend away from the opening. As to claims 11 and 12, Figure 17 shows two similar brackets with wings such that one of the wings extends from a gingival sidewall of the body and is curved back as the wing extends away from the opening, and another of the wings extends from an occlusal sidewall of the body and is curved back/forward as the wing extends away from the opening. As to claim 14, Figure 14A shows a portion of the body and the opening is curved laterally. As to claim 15, the body defines two openings (Figure 14A). As to claims 17, 19, 30 and 33, adhesive is bonded to the tooth and the bracket on a lingual surface of the tooth (column 10, lines 63-67). As to claims 20 and 34, Figures 15 and 16 show an orthodontic appliance (27,28) attached to a plurality of teeth, wherein at least one of the attachments is attached to a lingual surface of a front of one of the teeth.

9. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cash (US 5,616,026). Cash discloses an orthodontic bracket (10) for use with a wire to reposition a tooth comprising a body (14) defining a coextensive opening (30), wherein the body does not have a base with a surface area that bonds directly to the tooth (Figures 4D-4F) and wherein the body defines notches (66).

10. Claims 1, 16 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe (US 5,230,620). Watanabe discloses an orthodontic bracket for use with a wire to reposition a tooth comprising a body (2) defining a coextensive tubular opening (3,4), wherein Figure 1 shows the body does not have a base with a surface area that bonds directly to the tooth (column 1, lines 4-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Sahagian (US 6,299,438). Takemoto discloses an orthodontic bracket for use with a wire to reposition a tooth as previously described, but fails to show adhesive that encapsulates the bracket except for the opening. Sahagian, however, teaches a dental article that comprises an adhesion layer coating (column 4, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the applicant's invention to encapsulate the bracket within an adhesive layer so that another layer, i.e. a friction-reducing layer, could be further applied as taught by Sahagian.

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12. Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Fujita (US 4,354,833). Takemoto discloses an orthodontic bracket for use with a wire to reposition a tooth as previously described, but fails to show at least one other of the attachments is attached to a facial surface of a back one of the teeth. Fujita, however, teaches an orthodontic appliance that can be applied to the lingual or facial surfaces of the teeth (Figures 1 and 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have one other of the attachments attached to a facial surface of a back one of the teeth in order to correct teeth misalignment as taught by Fujita.

13. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Rosenberg (US 4,712,999). Takemoto discloses an orthodontic bracket for use with a wire to reposition a tooth as previously described, but fails to show a clip configured to hold the bracket during attachment. Rosenberg, however, teaches an orthodontic bracket with a clip (Figures 1-3) whereby the clip comprises a finger (8) that is receivable (Figure 2) in the bracket opening (7) and a handle portion (4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use a clip with the bracket of claim 1 in order to promote cleanliness and provide cosmetic advantages as taught by Rosenberg.

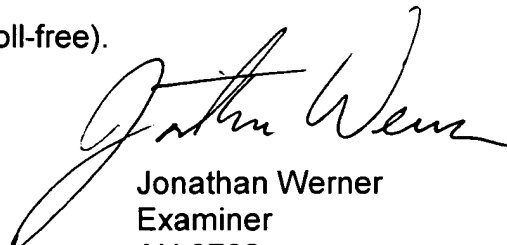
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to included form PTO-892 for all additional pertinent prior art related to orthodontic brackets.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Werner whose telephone number is (571) 272-2767. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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2/28/06


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